

OCT 13 2004

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FROM: John G. Posa
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OCT 13 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hetherington

Serial No.: 10/634,082

Group No.: 2832

Filed: August 4, 2003

Examiner: K. Lee

For: SUBSTANTIALLY RIGID CAPACITIVE JOYSTICK DESIGN

RESPONSE TO OFFICE ACTIONCommissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed July 14, 2004, the claims of this application are being resubmitted in unamended form for reconsideration in view of the following remarks.

All claims 1-15 stand rejected under 35 U.S.C. §103(a) over Thomas ('952) in view of Sharp ('219). With respect to claim 1, this claim includes the limitation of one or more controls on the handle of a substantially rigid joystick. The Examiner concedes that Thomas is silent with respect to this feature, but argues that it would have been obvious to provide the handle of Thomas with the actuator control as taught by Sharp "since the device of Sharp would provide the joystick of Thomas with additional Z-axis actuator means." Apart from the fact that there is no teaching or suggestion *from the prior art* to combine these references, the Thomas system already has a Z-axis control. "The control lever 12 is supported by a spring diaphragm 14 so as to be manually tiltable about axes X and Y and translatable along an axis Z." ('952 patent, column 2, lines 36-38). If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F2d 810, 123 USPQ 349 (CCPA 1959). Accordingly, claims 1-5 are allowable.

Claim 6 is formulated as a "consisting essentially of" claim, meaning the transitional phrase "consisting essentially of" limits the scope of the claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristics" of the claimed invention. *In re Herz*,

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537 F2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Although the burden is on Applicant to show that the introduction of additional components would materially change the characteristics of Applicant's invention, in this case, they would, and they do. The system of Thomas (and Sharp et al., for that matter) are entirely different from that of Applicant, in that both utilize different electrode/dielectric structures. The Examiner is invited to review MPEP §2111.03, rather than just ignore the way in which claims drafted in this form should be examined.

Regarding claims 6-7 and 9, the Examiner's rejection is "Please see above." Regarding claims 10-11 and 13, the rejection is "Please see Figure 1 of Thomas." Regarding claims 14 and 15, the rejection is "See Figure 14 of Sharp." These are not substantive rejections in any meaningful sense, and the Applicant respectfully requests that the Examiner be specific as to why these claims are being rejected, rather than referring to other arguments or figures in patents, leaving the interpretation of those references to Applicant. With particular reference to claim 10, which is an independent claim, the Examiner contends that one should look to "Figure 1 of Thomas." However, apart from the fact that Applicant does not know exactly what to look at, note that claim 10 includes a limitation of "a user-manipulable handle coupled to a base plate through a substantially rigid force-sensing element that allows only a slight deflection of the handle in response to an applied force." Among other limitations, Applicant cannot find this in "Figure 1 of Thomas," such that *prima facie* obviousness is expressly precluded. Moreover, claims 14 and 15 include further limitations of the force sensing element, namely, that it is composed of plastic, and that it is "neck down." Where, Applicant queries, is there a teaching or suggestion from the prior art sufficient to reject these claims?

Based upon the foregoing, Applicant contends that all claims continue to be in condition for allowance. Questions regarding this application may be directed to the undersigned by way of telephone, facsimile or e-mail to expedite prosecution.

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Respectfully submitted,

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